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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/040,117 01/04/2002 Steven Ausnit 769-222 Div.2 1073

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EXAMINER

SIPOS, JOHN

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 06/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,117

Applicant(s)

AUSNIT, STEVEN

Examiner

John Sipos

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 40-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 15 and 40-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claim 15, drawn to a method of making bags with pouring spouts, classified in Class 53, subclass 410.

Group II. Claims 40-42 and 48-50, drawn to the method of opening bags, classified in Class 53, subclass 492.

Group III. Claim 43, drawn to a method of making bags with zipper fasteners and sliders, classified in Class 53, subclass 412.

Group IV. Claims 44-47, drawn to a bag, classified in Class 383, subclass 64.

The inventions are distinct, each from the other, because of the following reasons:

The inventions of Groups I and III are related as **subcombination and combination**. A restriction requirement is based on the presumption that all claims of record define patentable inventions. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for its presumed patentability and (2) that the subcombination has utility by itself or in other combinations. (See MPEP 806.06(c)). In the instant case, a comparison of combination claim 43 and subcombination claim 15 provides evidence that the combination, as claimed, does not require the particulars of the subcombination, as claimed, for its presumed patentability. Subcombination claim 15 sets forth a fastener including a pouring spout. Combination claim 43 does not set

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forth these particulars and, consequently, does not require them for patentability. Even if other combination claims *do* set forth these particulars, distinction between the *inventions* is shown if any one-combination claim does not include the particulars of any one subcombination claim. The presence of the particulars in other combination claims indicates that they *may be* included as part of the combination, but the claims selected above provide evidence that the particulars are not *required*. (See MPEP 806.05(c), Example 3.) The subcombination has separate utility because it can be used in a packaging operation without the rest of the combination, for example without the tamper-evident feature as recited in the claims of Group III.

The inventions of Groups III and IV are related as **process of making and product made**. The inventions are distinct if either of the following can be shown: (1) that the process as claimed can be used to make other materially different products, or (2) that the product as claimed can be made by another materially different process (See MPEP 806.05(f)). In the instant case the bag claimed in the claims of Group IV can be made by a process other than the one set forth in the claims of Group III. For example, the tamper-evident feature, including the area of weakness and the opening for the slider, can be preformed on the film before feeding the film to the zipper attaching and bag forming device.

The inventions of Groups IV and II are related as **product and process of using the product**. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be

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used in a materially different process of using that product (MPEP 806.05(h)). In the instant case the process of opening the bag of Group II can be practiced with a different bag than the one recited in Group IV. For example, the process could be used with a bag that does not have an opening over the slider. Furthermore, the bag of Group IV can be opened by a method other than the one set forth in the claims of Group II. For example, the bag of Group II can be opened by slitting the other closed end of the bag.

The inventions of Groups I vs. II, IV and II vs. III are **independent inventions**.

Two **different combinations**, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent (See MPEP 806.04). The method of making the film for a bag (Group I), the method of opening the bag (Group II) and the bag (Group IV) are considered independent inventions. Similarly, the method of opening the bag (Group II) and the method of making the bag (Group III) are considered independent inventions.

Because these inventions are distinct for the reasons given above, and because they have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes, as indicated, is proper.

Applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even if the restriction requirement is traversed.

Applicant is reminded that, upon cancellation of claims to a non-elected invention, the **inventorship must be amended** in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one

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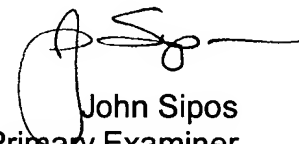
claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h). Applicant should further **amend the title**, in necessary, to reflect the elected invention.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 305-3579**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703) 308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.



John Sipos
Primary Examiner
Technical Center 3721

js